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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,922	07/26/2001	Richard G. Keiser	R0558/7001 RFG	8770
23628	7590	11/24/2003	EXAMINER	
WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2211			COBY, FRANTZ	
			ART UNIT	PAPER NUMBER
			2171	
DATE MAILED: 11/24/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/916,922

Applicant(s)

KEISER, RICHARD G.

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is in response to application filed on July 26, 2001 in which claims 1-12 are presented for examination.

**Status of Claims**

Claims 1-12 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 101 because claim 1, especially, recites a single means. Namely, "A configurable software system that compares the usage characteristics of computer file to a second data set" which does not appear in combination with another recited element of means. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable

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structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claims 2-8 are rejected at least for their dependencies on the rejected claim 1 above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanbongi et al. U.S. Patent no. 4,896,306.

As per claims 1-3, Sanbongi et al. disclose "a configurable software system that compares the usage characteristics of a computer file to a second data set in order to associate data from the second set with said file" by providing an electronic scheduler that stores a plurality of schedule data by combining time range data with corresponding schedule information (See Sanbongi et al. Abstract). In this case, the time range data is the characteristics of the computer file and the schedule information represent the second set, which relates to user's schedule activities.

As per claim 4, most of the limitations of this claim have been noted in the rejection of claims 1-3. Applicant's attention is directed to the rejection of claims 1-3 above. In addition, Sanbongi et al. disclose the claimed feature of "the second set of data is obtained by interfacing with another software program" by allowing schedule data to be read out from the memory and be displayed on a display unit (See Sanbongi et al. Abstract).

As per claim 5 most of the limitations of this claim have been noted in the rejection of claims 1-3. Applicant's attention is directed to the rejection of claims 1-3 above. In addition, Sanbongi et al. disclose the claimed feature of "where the association of data between the second set and said file is completed automatically, based on matching the date and time of current operation against a schedule of events with dates and times" (See Sanbongi et al. Col. 5, line 40-Col. 6, line 15). Notice: Sanbongi et al. provide an electronic with a schedule data search that allows time range data to be associated with schedule information of a user. Also, Sanbongi et al. requires no human interaction between the operation. Therefore, the claimed feature of the association of data between the second set and said file is completed automatically is clearly met by Sanbongi et al.

As per claim 6, most of the limitations of this claim have been noted in the rejection of claims 1-3. Applicant's attention is directed to the rejection of claims 1-3 above. In addition, Sanbongi et al. disclose "where a folder structure is generated

automatically according to the characteristics from the second data set" by providing a scheduler memory arranged according to a user's activities which are characteristics from the second data set (See Sanbongi et al. Figure 2 and corresponding text).

As per claim 7 most of the limitations of this claim have been noted in the rejection of claims 1-3. Applicant's attention is directed to the rejection of claims 1-3 above. In addition, Sanbongi et al. disclose "where the computer user has the capability of manually entering additional data to be associated with said file" by providing a data entry mechanism (See Sanbongi et al. Figure 3, component M3 and corresponding text) that allows the user of the electronic scheduler to manually entering data.

As per claim 8, most of the limitations of this claim have been noted in the rejection of claims 1-3. Applicant's attention is directed to the rejection of claims 1-3 above. In addition, Sanbongi et al. disclose the claimed feature of storing associated data file in a searchable database by providing a memory mechanism for storing data file associated with user schedule activities (see Sanbongi et al. Col. 2, lines 59-66) as well as a mechanism for searching and retrieving the data file (See Sanbongi et al. Figure 5 and corresponding text).

As per claims 9-10, all the limitations of these claims have been noted in the rejection of claims 1-8. They are therefore rejected as set forth above.


As per claims 11-12, all the limitations of these claims have been noted in the rejection of claims 1-8. They are therefore rejected as set forth above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

  
Frantz Coby  
Primary Examiner  
Art Unit 2171

November 10, 2003